

Keywords: specification, written description

General: A specification can communicate to a person of ordinary skill in the art that a patentee invented not just the combination of all identified features but also sub-combinations of the features – which may achieve the purposes of an invention even without the omitted features.

*SCRIPTPRO, LLC AND SCRIPTPRO USA, INC v.
INNOVATION ASSOCIATES INC.,*

Case no. 2013-1561

Decided August 6, 2014

I. Facts

ScriptPro, LLC and ScriptPro USA, Inc. (collectively “ScriptPro”) owns a patent for a “Collating Unit” (U.S. No. 6,910,601, hereinafter referred to as the ‘601 patent). ScriptPro sued Innovation Associates, Inc. for infringing claims 1, 2, 4, and 8 of that patent, with claims 1 and 8 being independent. The asserted claims are directed toward a collating unit that automatically fills and labels pill bottles or other prescription containers. Claim 1 is reproduced below.

1. A collating unit for automatically storing prescription containers dispensed by an automatic dispensing system, the collating unit comprising:
 - a storage unit for storing the containers delivered by an infeed conveyor;
 - a plurality of holding areas formed within the storage unit for holding the containers;
 - a plurality of guide arms mounted within the storage unit and operable to maneuver the containers from the infeed conveyor into the plurality of holding areas; and
 - a control system for controlling operation of the infeed conveyor and the plurality of guide arms.

All of the claims included in the original application issued without change, and begin with the same preamble shown above in claim 1.

When ScriptPro brought the infringement suit against Innovation Associates, Innovation Associates counterclaimed on various grounds, including invalidity. In particular, Innovation Associates argued that claims 1, 2, 4, and 8 were invalid because the specification of the ‘601 patent does not describe the subject matter of the asserted claims, which do not recite sensors. Innovation Associates asserted that the specification

stated the collating unit broadly includes a plurality of sensors to determine if a holding area is full or empty. The application also describes the operation of a collating unit having a plurality of sensors in several locations, including the abstract, the summary of the invention, and the preferred embodiments of the invention. Innovation Associates argued that, due to such disclosure, the specification limited the invention to a collating unit that uses sensors to determine if a particular holding area is full when selecting a holding area to hold the prescription container.

The district court agreed with Innovation Associates and granted summary judgment based only on the conclusion that the specification describes a machine containing sensors whereas the claims at issue claim a machine that need not have sensors. The court also rejected, as insufficient to prevent summary judgment, the deposition testimony and unsworn report of ScriptPro's expert, Dr. Faddis, who stated that it is clear from the written description how sensors are not required to practice the claimed invention. ScriptPro appealed the decision, raising only a written-description issue.

II. Issue

Did the district court err in granting summary judgment for Innovation Associates and holding that the recited claims lacked written description support?

III. Decision

Yes. The written description supports the limitations of asserted claims 1, 2, 4, and 8.

As noted above, the specification of the '601 patent describes embodiments of the collating unit that employ a plurality of sensors. However, that does not necessarily mean that the invention requires a collating unit with such sensors. The court recognized that it is common, and often permissible, for claims to recite only a subset of the full range of described features, while omitting others. The court stated that the specification can adequately communicate to a skilled artisan that the patentee invented not just the combination of all identified features, but combinations of only some of those features (sub-combinations), which may achieve the stated purposes even without the omitted features.

Turning to the specification of the '601 patent, the court found that there is no sufficiently clear language that limits the invention to a collating unit having a plurality of sensors. For example, the abstract states that the collating unit broadly includes a plurality of sensors. However, the court found that term "broadly includes" suggests that there are allowed exceptions to what the collating unit will include most, or almost all, of the time, and does not state or imply that a plurality of sensors are required in the collating unit. The court also found that the disclosure of the operation of a collating unit having a plurality of sensors merely describes what the sensors do when they are present;

it does not declare that they must be present. The court further noted that the specification also includes other statements that positively suggest that the plurality of sensors were an optional, though desirable, feature of the collating unit. For instance, the court pointed to certain portions of the specification that describe an embodiment in which the sensors are used for confirmation, which implies that other means, such as a control system, may be used to determine whether a particular holding area is full. Furthermore, the court found that the specification states that a control system, as recited in the claims, may store information that allows an operator to determine which holding area contains which containers. Accordingly, the court concluded that a person of ordinary skill in the art would recognize the specification as teaching a collating unit that achieves the intended purpose without the use of sensors.

Additionally, the Federal Circuit noted that when a specification is ambiguous about which of several features are stand-alone inventions, the original claims may help resolve the ambiguity. As noted above, the claims of the '601 patent issued without amendment to the claims. Because the independent claims did not include a recitation of sensors, the omission fits the bases of the specification for deeming the plurality of sensors to be optional, rather than required.

IV. Conclusion

The Federal Circuit concluded that claims the district court had erred in the grant of summary judgment that claims 1, 2, 4, and 8 of the '601 patent were invalid under 35 U.S.C. § 112, paragraph 1. Accordingly, the judgment of the district court was reversed.